Hovsepian v. Apple, Inc.
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EXHIBIT J

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EXAMINER
[illegible]

[illegible]

FINNEGAN, HENDERSON, FARABOW,
GARRETT AND DUNNER
1300 I STREET, N.W.
WASHINGTON, DC [illegible]

ART UNIT	PAPER NUMBER
2614	10

DATE MAILED: 12/30/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☑ Responsive to communication filed on 09/21/94 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire -3- month(s), -0- days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ ______

Part II SUMMARY OF ACTION

1. ☑ Claims 1-61 are pending in the application.

   Of the above, claims ______ are withdrawn from consideration.

2. ☑ Claims 1-32 have been cancelled.
3. ☑ Claims 35-38, 40-42, 44-47 are allowed.
4. ☑ Claims 33, 34, 39, 43, 48-58 are rejected.
5. ☑ Claims 59-61 are objected to.
6. ☐ Claims ______ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on ______. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on ______, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed ______, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. ______ ; filed on ______.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

1. This Office Action is in response to the Amendment filed on 09/21/94 and it is made non-final.

2. Claims 21-49 have been renumbered as claims 33-61, respectively, according to Rule 126.

Specification

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention, and the specification, as originally filed, does not provide support for the invention as is now claimed.

The claimed subject matters of "a transmitter, coupled to the conversion means, for coordinated transmission" (claim 33), protected data recognizing means and disabling means (claims 39, 43), receiving data at a non-real time rate (claims 48, 52) are not disclosed in the originally filed specification.

The specification fails to provide the actual hardware structures to support the claimed "recognizing means for recognizing protected data" and "disabling means".

Claim Rejections - 35 USC § 112

4. Claims 33, 34, 39, 43, 48-57 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

5. Claims 48-51, 53, 54 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 48, line 2, the use of a ";" after the recitation "a local reception system comprising" is suggested to be modified.

Regarding claim 48, lines 13-15, the electrical couplings for the claimed "converter" and other elements of the local reception system is not clearly provided.

Regarding claim 48, line 15, the recitation "the at least one audio/video program" lacks antecedent basis.

Regarding claim 50, line 6, the recitation "the local distribution system" lacks antecedent basis.

Regarding claim 53, line 3, the recitation "the at least one audio/video program" lacks antecedent basis.

Regarding claim 53, it is unclear of when, during the claimed method, the "decompressing" step is carried out.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 33, 34, 48-54, 58 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ballantyne et al.

Regarding claim 33, Ballantyne et al's disclosure of a central distribution library being a central depository for movie data, comprising the process of appending unique identification code for each movie type to digital video data, and converting digital video data into light energy for transmission over communication network, see Figure 1b, column 3, line 59 to column 4, line 56, conforms to the claimed library means, identification encoding means, conversion means and transmitting means of the claim 33's transmission system.

Regarding claim 34, the limitation of the plurality of library being geographically separated is inherent from Ballantyne et al's teaching that regional distribution library is provided in each of the geographical areas.

Regarding claims 48-54 and 58, the claimed procession station, local distribution system comprising of receiving means, storing means, transmitting means are disclosed in Ballantyne et al's movie distribution method comprising the processes of compressing, digitizing data, sending digitized compressed signals to a receiver, converting to corresponding electronic signals, temporarily storing the converted signals, decompressing the signals and passing the decompressed signals to viewer, see column 6, line 57 to column 7, line 8.

Allowable Subject Matter

8. Claims 39, 43, 55-57 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

9. Claims 35-38, 40-42, 44-47 are allowable over the prior art of record.

10. Claims 59-61 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda Le whose telephone number is (703) 305-4769. The examiner can normally be reached on Monday-Thursday from 8:00 AM-5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin, can be reached on (703)305-4714.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Amanda Le

Amanda Le

December 21, 1994

STEPHEN CHIN
SUPERVISORY PRIMARY EXAMINER
GROUP 2600